

### **REMARKS**

Currently claims 16, 17, 19 and 21-30 are presented.

Claim 16 has been amended to correct a claim consistency in the claim. Claim 16 as amended recited that the designated area is being modified based on a colorimetric value of said official postal product or a personal image. It is believed that claim 16, as currently set forth, is patentably distinct over the prior art.

The Examiner, in the Official Action, provided new grounds of rejection of the pending application. In particular, the Examiner has rejected claims 16, 17, 19, 21-25 and 27-30 under 35 USC § 103(a) as being unpatentable over Kaplan (US 5,873,605) in view of Kurosawa et al. (US 6,035,059). The Examiner states that Kaplan discloses a personal image product having a top surface and a bottom surface wherein the top surface has a personal image having a designated area where an official postal product may be placed and that the designated area may be modified based on the characteristics of the official postal product or personal image. Applicant respectfully submit that the Kaplan reference does not teach or suggest the product claimed. In particular, the second designated area is simply the place wherein the image of the person is placed. There is no teaching or suggestion of modifying that area based on the colorimetric value of the official postal product or the personal image. The passage recited by the Examiner (column 4, lines 26-44) simply discloses the providing of the image of the person in the second region. As illustrated in Figures 4a and 4b, the designated area is modified so as to provide a colorimetric value or appearance that either matches the official postal product 30 or the image on the product. Thus, there is provided a transition between the personal image and the personal image product. As set forth at page 5, lines 3-6 of the present application, the personal image 15 on the personal product 10 of the present invention has a designated area 35 illustrated by the outer dash line 40 based on one or more of the characteristics of the personal image 15 or the official postal image on the stamp 30. Thus, it is the designated area that has been modified with respect to either the official postal product or the personal image product. This is not taught or suggested by Kaplan. Quite the contrary, Kaplan merely discloses providing of a personal image in a designated location. There is no

teaching or suggestion of modifying characteristic value of that portion of the designated area as taught and claimed by Applicant. One of the problems which the present invention is directed is providing aesthetically pleasing product that includes an official postal product in a personal image. By modifying the designated area, a more aesthetically pleasing product can be placed. In addition, the present invention also provides that if the official postal product is not placed exactly in a prescribed boundary, there will be no degradation of the appearance. This is clearly not taught or suggested by the prior art.

With respect to the '059 reference, this reference is of little relevance to the present invention. This reference is directed to image processing system suitable for character recognition of printed matter on handwritten characters such as those on lips. This reference is merely directed to the recognition of colored input images. This reference does not teach or suggest of providing this with an official postal product. It does not teach or suggest the providing this with a personal image as taught and claimed by Applicant. There is no teaching or suggestion as to why one would take the '059 reference and combine it with Kaplan. Quite the contrary, the two are totally unrelated to each other and there would be no teaching or suggestion of combining the two references. The CAFC stated in *In re Lee* 277 Fed 3<sup>rd</sup> 1338 (61 USPQ 2<sup>nd</sup> 1430) 2002 at page 1433.

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness ... Our case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references ... teachings of references can be combined only if there is some suggestion or incentive to do so”.

The Court further stated at page 1434:

“the examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”.

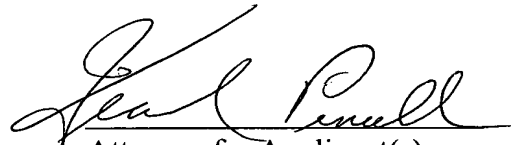
As previously noted, the Kaplan reference is directed to providing a personal image on a stamp. Whereas the '059 reference is simply directed to image processing system suitable for color character recognition. There is no motivation or suggestion of why one would combine one with the other. Furthermore, the present invention is directed to modifying designated area in accordance with the colorimetric characteristics of either the personal image or the stamp. Clearly, neither of these two references teach or suggest this.

Claims 17, 19, 21, 22-24 depend at least ultimately upon independent claim 16 and therefore are patentably distinct for the same reason as the independent claim upon which they depend.

There are two additional independent claims, claims 25 and 29, which include the limitation of either of modifying the personal image in response to at least one colorimetric value of the official postal product or modify at least one colorimetric value of the personal image product in response to at least one known colorimetric value of the official image product. As previously discussed, these features are not taught or suggested in Kaplan or Kurosawa et al. Thus, these claims are patentably distinct for the same reasons previously discussed. The remaining claims depend at least ultimately thereon on either of these two independent claims and therefore are also patentably distinct over the cited art.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Frank Pincelli", written over a horizontal line.

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